

Application No.: 09/783,899
Amendment Dated: December 13, 2005
Reply to Office Action of: September 26, 2005

MTS-3244US

Remarks/Arguments:

Claims 1-42 stand rejected.

Applicants thank the Examiner for the opportunity to discuss claim 1 in view of the cited references during a personal Interview conducted at the USPTO on November 29, 2005.

Claim Objections

Claims 1-38 has been objected-to, because "characterized in that" language is used. Applicants have now amended the claims, so that such language is deleted.

Section 103 Rejections

Claims 1-42 have been rejected as being obvious in view of Ebisawa and Ellis. Applicants respectfully submit that this rejection is overcome for the reasons set forth below.

Amended claim 1 includes features which are not suggested by the cited references, namely:

- advertisement data which are to be reproduced when an audience watch a program are recorded in the area in advance of the user watching the program, and **the large-capacity recording medium is thereafter provided to the user**, and
- storing, at a location separate from the user's location, the advertisement data in the user's large-capacity recording medium **prior to receiving advertisement data from a broadcast station; and subsequently placing the user's medium at the user's location**; and
- **after** storing the advertisement data in the user's large-capacity recording medium **and** placing the user's large-

capacity recording medium at the user's location, selectively synthesizing the program watched by the user with portions of the advertisement data **previously** stored in the user's large-capacity recording medium.

As discussed during the Interview, claim 1 recites that the storing of the advertisement data is performed at a location separate from the user's location. Furthermore, as now recited in amended claim 1, such **storing is performed prior to receiving advertisement data from a broadcast station**. Claim 1 further recites that **after storing the advertisement data in the recording medium, the same recording medium is subsequently placed at the user's location**.

The invention advantageously allows the user to purchase a storage medium at a reduced cost, because the user has permitted sets of advertisement data to be separately stored in the user's storage medium. The user then purchases this storage medium at a reduced cost, takes it home and, subsequently, turns the system (storage medium) ON to view television programs and other inserted advertisement data.

As also required by claim 1, the advertisement data is recorded in the storage medium **at a location separate from the user's location and prior to receiving advertisement data from a broadcast station**. Furthermore, after the user's storage medium is placed at the user's location, then the advertisement data, which was previously stored in the recording medium, is selectively synthesized with a program watched by the user.

Ebisawa, on the other hand, discloses a video data receiving apparatus that receives video and advertisement data. As shown in Figure 4, the advertisement data from the broadcasting station is received and stored in unit 207. The user synthesizes the stored advertisement data with the program data, **both having been received from the television broadcasting station**. Ebisawa does **not** disclose storing separate sets of advertisement data in the user's separate storage medium, **prior to receiving the sets of advertisement data from the broadcast station**.

The Examiner states, however, that Ellis discloses storing separate sets of advertisement data in a user's storage medium. The Examiner states that Ellis discloses that advertisements such as default priority advertisements may be distributed separately from other advertisements. For example, default priority advertisements may be received and stored earlier for repeated presentation over several days, weeks, months, etc. Furthermore, default priority advertisements **may be stored as part of the application or as part of non-volatile memory.** The Examiner understands this to mean that advertisement data may be stored in the user's storage medium, prior to the user placing the storage medium at his location.

Applicants respectfully submit that the Examiner is misinterpreting the disclosure of Ellis. Applicants note that in Figure 1, the user uses a set-top box (70) which is located at the user's location (66). A television distribution facility (56) selects advertisement data that is received either from a local advertisement customer (84) or from a national advertisement customer (82). The television distribution facility (56) then transmits either local advertisement data (84) or national advertisement data (82) for storage by the user, at the user's location. Applicants note that all advertisement data, whether local advertisement data or national advertisement data, **is always received by way of television distribution facility (56) and stored into the user's set-top box (70).** There is **no** disclosure of the set-top box being programmed with advertisement data and, **then afterwards**, the set-top box being placed at the user's location.

Applicants respectfully submit that when Ellis states that default priority advertisements may be stored as part of the application or as part of the non-volatile memory, he means that the set-top box includes an application program or non-volatile memory for allowing the advertisement data sent from the television distribution facility (56) to be stored within the set-top box. Without the application program and/or without the non-volatile memory, the set-top box would not be able to store such advertisement data.

Accordingly, Ellis teaches that the set-top box, which may be purchased by a user, includes an application program or non-volatile memory at the time of

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purchase. However, Applicants emphasize that the set-top box does **not** include any previously stored advertisement data that has been stored within the set-top box, before the set-top box is placed at the user's location.

Again, Applicants note that the set-top box has the capability of receiving default priority advertisement data from the television distribution facility but it must do so while the set-top box is at the user's location. There is **no** suggestion of the set-top box having default priority advertisement data stored within the application program or non-volatile memory, prior to being placed at the user's location and prior to having received advertisement data from the television distribution facility.

Claim 1 requires that the user's storage medium include advertisement data within it. The advertisement data, stored within the storage medium, are both together taken by the user and then placed at the user's location. When the broadcasting station transmits program data, the user's storage facility already includes the sets of advertisement data.

Applicants respectfully request that the Examiner reconsider his interpretation of the disclosure of Ellis. Applicants submit that Ellis does not disclose the above features of amended claim 1.

Although not the same, claims 2 and 39 include features similar to amended claim 1. Amended claims 2 and 39 are, therefore, not subject to rejection in view of the cited references for the same reasons set forth for amended claim 1. Favorable reconsideration is requested.

Dependent claims 3-38 depend from amended claims 1 and 2, and dependent claims 40-42 depend from amended claim 39. These claims are, therefore, not subject to rejection in view of the cited references for at least the same reasons set forth for amended claim 1.

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Conclusion

Claims 1-42 are in condition for allowance.

Respectfully submitted,

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Fran Petrella

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